

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Hongyong Zhang	Art Unit :	2826
Serial No. :	09/804,654	Examiner :	Thomas L. Dickey
Filed :	March 12, 2001	Conf. No. :	1999
Title :	SEMICONDUCTOR DEVICE AND METHOD OF MANUFACTURING THE SAME		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application. The Notice of Allowance including a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b), mailed June 2, 2008, for the above-referenced application states that the Patent Term Adjustment at allowance is 0 days. The PAIR system shows a PTO Delay of 0 days and an Applicant Delay of 283 days. Correction of the Patent Term Adjustment calculation is respectfully requested in the manner described herein.

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: August 29, 2008

I. REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated delays that affected the Patent Term Adjustment (PTA) calculation as follows:

- A. The PTO mailed a non-final Office Action on January 3, 2002, to which Applicant submitted a response on May 1, 2002. The PAIR system indicates the PTO received the response on May 10, 2002, thereby according an Applicant Delay of 37 days. Applicant concurs with this patent term adjustment calculation.
- B. On August 4, 2003, Applicant filed a Petition to Withdraw the Holding of Abandonment. The PTO did not issue its Decision on Petition until June 6, 2006, nearly three years later. No PTO Delay was assessed for the PTO's delayed response to this petition. Applicant respectfully requests reconsideration of this PTA calculation.
- C. The PTO mailed a non-final Office Action on July 11, 2006. The PTO mailed the July non-final Office Action again on September 1, 2006. The PTO then mailed a new non-final Office Action on February 28, 2007, in which the Examiner specifically states the following on page 2: "The non-final Office action mailed on 09/01/2006 was improper in that it failed to address all pending claims. This Action is non-final. Applicant's time to respond resets on the mailing of this Action." Applicant subsequently submitted a response on June 14, 2007. The PTO accorded an Applicant Delay of 246 days for a delayed response. Applicant respectfully submits that the PTO's calculation of Applicant Delay contains an error and that the correct total Applicant Delay for this response is 17 days.
- D. In good faith and candor, Applicant notes that, for several filings for which Applicant Delay should have been assessed, no Applicant Delay was accorded. Applicant submits details of these in the discussion that follows.
- E. The PTO calculates a total PTO Delay of 0 days and a total Applicant Delay of 283 days, for a total net PTA of 0 days. Applicant respectfully submits that the PTO's calculation of Applicant Delay contains an error and requests its correction.

II. CALCULATION OF APPLICANT DELAY

A. Applicant Delay Should Not Be Calculated from July 11, 2006, as Examiner Restarted Period for Response in Subsequent Action

On July 11, 2006, the PTO mailed a non-final Office Action. The PTO then again mailed to Applicant the same July 11, 2006, non-final Office Action on September 1, 2006. The PTO then mailed a new non-final Office Action on February 28, 2007, in which the Examiner specifically states the following on page 2: "The non-final Office action mailed on 09/01/2006 was improper in that it failed to address all pending claims. This Action is non-final. Applicant's time to respond resets on the mailing of this Action."

The Examiner also indicated in the Interview Summary mailed therewith on February 28, 2007, that the "[p]revious action mailed 01 September 2006 will be vacated because it failed to address all the claims. A new action which address [sic] all the pending claims will follow." Applicant subsequently submitted a response to the outstanding action on June 14, 2007. The PTO accorded an Applicant Delay of 246 days for a delayed response to the July 11, 2006, action.

As the Examiner later vacated the action of September 1, 2006, which was in all substantive respects exactly the same as the action mailed on July 11, 2006, Applicant respectfully submits that neither action required response. The PAIR record also supports this conclusion, as both the Transaction History and Patent Term Adjustment History tabs indicate that a new response period was begun with the mailing of both the September 1, 2006, action and also again with the mailing of the February 28, 2007, action. Applicant notes that entries of "09-01-2006 Mail Notice of Restarted Response Period" and "02-28-2007 Mail Notice of Restarted Response Period" appear in PAIR.

In view of the foregoing, Applicant submits that the PTO's calculation of Applicant Delay contains an error and respectfully requests a reduction of 229 days of Applicant Delay for this response. As such, Applicant asserts that the correct total Applicant Delay associated with this response is 17 days. This calculation represents the time between expiration of the three-month period for reply on May 28, 2007, and the response's receipt date at the Office on June 14, 2007.

B. Applicant Delay Was Not Assessed for Certain Papers for Which Applicant Delay Should Have Been Assessed

1. On June 3, 2003, the PTO mailed a Notice of Abandonment for non-responsiveness. On August 4, 2003, Applicant filed a Petition to Withdraw the Holding of Abandonment indicating the Office Action in question had never been received. The petition was ultimately granted. Pursuant to 37 C.F.R. § 1.704(c)(4), Applicant notes, in good faith and candor, that 1 day of Applicant Delay should have been assessed for submission of the petition outside of the two-month period for reply from the mailing date of the Notice of Abandonment.

2. On January 11, 2008, the PTO mailed a Notice of Allowance. Applicant filed a response to the outstanding action on April 10, 2008. Subsequently, Applicant filed a Request for Initialed PTO Form 1449, identified in PAIR as a Miscellaneous Incoming Letter, on April 11, 2008. No Applicant Delay was assessed for this filing. In addition, on May 9, 2008, Applicant filed a Request for Continued Prosecution. Again, no Applicant Delay was assessed for this filing. In good faith and candor, Applicant expects that these filings would be treated as "supplemental" replies pursuant to 37 C.F.R. § 1.704(c)(8) and that a delay should have been assessed for the time elapsing – a total of 29 days – between the initial response on April 10, 2008, and the last "supplemental" reply on May 9, 2008.

III. CALCULATION OF PTO DELAY

A. PTO Delay Was Not Assessed for a Delayed Decision on Petition for which PTO Delay Should Have Been Assessed

In 37 C.F.R. §§ 1.703(a)(2)-(a)(3), applicants are provided a period of adjustment of patent term due to examination delays to account for PTO replies that are mailed more than four months from the date of receipt of an applicant's filing.

As indicated above, on June 3, 2003, the PTO mailed a Notice of Abandonment to which Applicant responded by filing a Petition to Withdraw the Holding of Abandonment on August 4, 2003. The PTO did not act on this petition for nearly three years, ultimately granting Applicant's petition on June 6, 2006. The time that elapsed between expiration of the four-month period for reply on December 4, 2003, and the Decision on Petition's mailing date of June 6, 2006, was 915 days.

As such, Applicant respectfully requests reconsideration of the calculation of PTO Delay for the above-referenced Decision on Petition to include a PTO Delay of 915 days.

B. Applicant Expects PTO Delay to Be Calculated Under 37 C.F.R. § 1.702(b) at Issuance

While Applicant notes that PTO Delay granted under 37 C.F.R. § 1.702(b) is generally not calculated until the date of issuance, given the presence of a Request for Continued Examination in the file history of the instant application, it is possible to account for the time that will be accorded to the Applicant under that rule. In particular, Applicant submits that the PTO Delay to be assessed under the “three-year rule” should be calculated from the day after three years passed from the filing date until the date of the filing of the Request for Continued Examination, or from March 13, 2004, through May 9, 2008, less any time for PTO Delay already granted under other rules.

Accordingly, Applicants expect to receive a total of 1519 additional days of PTO Delay at issuance.

IV. REMARKS

In consideration of the events described above, Applicant believes the current calculation of 283 days of Applicant Delay is incorrect.

Applicant therefore respectfully requests recalculation of the PTA calculation in the following manner to reflect a total of 84 days of Applicant Delay:

- 37 days for delayed response to January 2002 Office Action;
- Addition of 1 day for delayed response to Notice of Abandonment;
- Reduction of 229 days of Applicant Delay from 246 days to a total of 17 days for delayed response to February 2007 Office Action; and,
- Addition of 29 days for "supplemental" replies to January 2008 Notice of Allowance.

Applicant also respectfully requests recalculation of the PTA calculation at issuance in the following manner to reflect a total of 1519 days of PTO Delay:

- Addition of 915 days for delayed response to Petition to Withdraw Holding of Abandonment and addition of 604 days for issuance beyond 3 years from filing; or
- Addition of 1519 days for issuance beyond 3 years from filing.

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

8/29/08



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